IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 1647
EISENBACH-SCHWARTZ et al	)	Examiner: B. Bunner
Appln. No.: 09/314,161	)	Washington, D.C.
Filed: May 19, 1999	)	September 14, 2001
For: ACTIVATED T-CELLS, NERVOUS SYSTEM-SPECIFIC ANTIGENS AND THEIR USES	)	Atty.Docket: EIS-SCHWARTZ=2

RESPONSE

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

The present communication is responsive to the official action of June 14, 2001, a petition for a two-month extension of time and payment of late fee being attached hereto.

Claims 1-37 presently appear in this case. Claims 9-15, 17, 18, and 20-37 have been withdrawn from consideration. The remaining claims have been subject to a new restriction requirement.

The examiner has repeated and made final the previous restriction requirement and has therefore withdrawn claims 9-15, 17, 18, and 20-37 from further consideration. The examiner, however, has further restricted the elected invention as follows:

Group I-A, including claims 1-8, 16, and 19, drawn to a method for preventing or inhibiting neuronal degeneration in the central nervous system, and

Group II-B, including claims 1-8, 16, and 19, drawn to a method for preventing or inhibiting neuronal degeneration in the peripheral nervous system.

The examiner concedes that there are no provisions in the MPEP for inventive groups that are directed to different methods. Nevertheless, the examiner deems the restriction proper because she considers the methods to be patentably distinct. The examiner states that the methods require different ingredients, process steps and end points, and require search and consideration of different art. This restriction requirement is respectfully traversed.

It is not understood why the examiner states that the treatment of the CNS and the treatment of the PNS require different ingredients, process steps and end points. This statement is not supported by data from the specification. Thus, the examiner has no reason to believe that this is the case. Furthermore, this should be an election of species rather than a restriction as all of the claims are generic. There is no justification for treating the CNS/PNS dichotomy any differently from the injury/disease dichotomy discussed below. The latter was the subject of an election requirement, as would be appropriate if the species were actually patentably distinct (which they are not for the reasons discussed below). The same should be true for the first dichotomy.

Nevertheless, applicants hereby elect with traverse Group I-A drawn to a method for preventing or inhibiting neuronal degeneration in the CNS.

The examiner considers the treatment of injury and disease to be patentably distinct species of the claimed invention and requires election for prosecution on the merits, although the examiner has indicated that if a generic claim is finally held to be allowable, both will be examined. This requirement is respectfully traversed.

The claims are directed to a method which is identical regardless of whether that which is being treated is an injury or a disease. Accordingly, it is inappropriate to consider the two to be patentably distinct. All of the method steps are the same and the only difference is in the preamble. Accordingly, reconsideration and withdrawal of the species requirement is respectfully urged. Nevertheless, in order to be responsive, applicant hereby elects injury. Claims 1, 2, 4, 5, 6, 7, 8, 16, and 19 are directed to the elected invention and the elected species.

The examiner states that if applicant selects inventions I-II, one species from the group of nervous system defects must also be chosen to be fully responsive. This statement is respectfully traversed. From the present restriction requirement it is not clear why one species from the group of nervous system defects must be chosen to be fully responsive. The examiner has not made a species requirement with respect to nervous system defects other than with respect to injury and disease which has already been traversed and provisionally elected hereinabove. To the extent that this sentence is supposed to be a new species requirement, it is

respectfully requested that the examiner spell out the reasons therefor. In order to be responsive, however, applicant further elects the sub-species of spinal cord injury.

Reconsideration and withdrawal of the restriction and election requirements and prompt action on the merits and allowance of all the claims now present in the case is earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By Roger L. Browdy
ROGER L. BROWDY
Registration No. 25,618

by Allen Yun
Reg. No. 37,971

RLB:al
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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